

## REMARKS

Claims 1-12 are pending in this application. Applicants respectfully request reconsideration of claims 1-12.

### Claim Rejections

Claims 1-8, 10-11 have been rejected under 35 U.S.C. §102(e) as being anticipated by Hultgren (US Pat. No. 6,868,391). Claims 9 and 12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hultgren in view of official notice.

Regarding claim 1, Applicants previously argued that “Hultgren does not teach a customer providing a merchant with a customer identifier.” Amendment A, page 7. The Examiner characterized the Applicants’ argument as “Hultgren does not teach the customer identifier is transmitted to the merchant or the a [sic] settlement house.” Final Office, Action page 6. For the record, this is not an accurate representation of the Applicants’ argument. Applicants never argued that the customer identifier is not transmitted to the settlement house, and instead noted that in Hultgren “the customer identifier is provided to module 202 which, as illustrated in FIG. 2, is a component of telepay TSN 30.” Amendment A, page 7.

The Examiner’s rebuttal begins by directing Applicants’ attention again to FIG. 3A item 300 and stating “[c]learly a customer ID is provided” Final Office, Action page 6. Applicants never disputed that item 300 teaches that a customer ID is provided, but as noted in Amendment A, “item 300 does not illuminate what entity obtains the customer identifier” Amendment A, page 7. Applicants previously showed that “[a]lthough the customer identifier is provided to the module 202 of telepay TSN 30, Hultgren does not teach or suggest that the customer identifier is ever transmitted to the merchant terminal 70.” Amendment A, page 7.

The Examiner continues with what appears to be an argument of inherency, saying “that some customer ID must be sent along to the merchant and ultimately the settlement house otherwise the transition [sic] could not be complete.” This argument presupposes that the

merchant necessarily is the conduit of information between the customer and the telepay TSN

30. However, this is not the case in Hultgren. Hultgren teaches that:

a customer who operates customer mobile station 60 seeks to purchase goods or services from a merchant. The merchant has merchant terminal 70 which functions as a computerized cash register and which has modem connection to PSTN 50. The customer via customer mobile station 60 can make payment for the goods or services using telepay TSN 30, and particularly can transfer funds from the customer's account in customer financial institution 80 to the merchant's account in merchant financial institution 90. (col. 4 lines 13-22).

FIG. 5A depicts a first mode of the invention, in which the transaction occurs while the customer is at the merchant's premises 92A. At the merchant's premises 92A the customer acquires the merchant identifier and the transaction amount." (col. 4 lines 27-31).

In brief, suppose that the customer wants to pay \$100US for a good or service, or for payment of a bill or invoice (such as a utility bill, for example). In accordance with the present invention, the customer merely dials the directory number of the telepay TSN 30 (e.g. a A1-800" directory number) and, in response to prompts generated by telepay TSN 30, enters a merchant identifier and a transaction amount (\$100US). (col. 4 lines 48-55).

As depicted by event E1 in FIG. 1, the customer merely dials on customer mobile station 60 the directory number of the telepay 30. (col. 6 lines 17-19).

[A]t step 334 transfer coordination module 206 directs that a transaction verification request message be sent to merchant terminal 70. In this regard, transfer coordination module 206 provides verification unit 204-3 with the current to [sic] transaction code, the merchant identifier, and the transaction amount. Verification unit 204-3 in turn generates a verification request message which is transmitted to merchant terminal 70 and depicted as event E9 in FIG. 1. (col. 8 lines 32-40).

It should be abundantly clear from the above quoted sections of Hultgren that the customer communicates directly with the telepay 30 and therefore it is simply not necessary for the customer to provide a customer ID to the merchant. The customer ID is provided directly to the telepay 30 from the customer mobile station 60 and does not pass through the merchant terminal 70 (see FIGs. 1, 1A, and 1B). To complete the transaction, the customer provides the customer ID, a merchant identifier, and the transaction amount to the telepay 30 and the funds

are transferred to the merchant's account. Even when a transaction verification request message is sent to merchant terminal 70, the message only is taught to contain the transaction code, the merchant identifier, and the transaction amount, but not the customer ID. In short, the method of Hultgren is able to complete a transaction without ever providing the customer ID to the merchant terminal 70, even as part of the verification request message.

Applicants also argued in Amendment A that Hultgren does not teach the limitation of claim 1 of "the customer selecting a payment method and transmitting the selected payment method to the settlement house." Amendment A, page 8. The Examiner responded by pointing to FIG. 3B [sic] item 306 and stating "[c]learly the customer selects the payment and this information must be submitted to the settlement house otherwise the transaction could not happen. There also can be a default selection which is a selection in itself." Final Office, Action page 6.

Applicants maintain that Hultgren only teaches a prearranged payment method, as detailed in Amendment A. Since the payment method is prearranged, the transaction can happen without the customer making a payment method selection. It is Applicants' position that a system that employs a default selection cannot read on the limitation of "the customer selecting a payment method" since the customer does not actually select the payment method when paying for goods or services. Here, the claim language requires that the customer make a selection, and Hultgren does not teach the customer making a selection since the payment method is prearranged. Further, since the payment method is prearranged, the customer in Hultgren does not transmit the selected payment method to the settlement house, as required by claim 1.

Regarding claim 11, Applicants rebutted the Examiner's initial rejection in Amendment A. In the Final Office action, the Examiner repeated the rejection but did not address the Applicants' rebuttal argument. MPEP §707.07(f), entitled "Answer All Material Traversed," states "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

Finality of the Office Action is Improper

Regarding claim 12; the Applicants noted in Amendment A the lack of a supporting argument for the rejection under 35 U.S.C. §102(e) in the non-final Office Action. Applicants further argued why Hultrgen did not teach the limitation of claim 12. In the Final Office Action the Examiner switched to a new ground of rejection under 35 U.S.C. §103(a) and took Official Notice. Applicants contend that the Office Action was therefore improperly made Final since Applicants did not amend any claims.

Further, MPEP §2144.03(B) notes that “[t]he applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice **and be allowed to challenge the assertion in the next reply** after the Office action in which the common knowledge statement was made.” (emphasis added). Here, since Official Notice was not taken until the rejection was made Final, prosecution is now closed and Applicants cannot challenge the assertion. Applicants also note MPEP §2144.03(D) titled “Determine Whether the Next Office Action Should Be Made Final” which clearly implies that Official Notice should only be taken in a non-final Office Action so the applicant can have an opportunity to respond. Per MPEP §706.07 “[i]n making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated.” Here, the basis of the rejection of claim 12 has not been reiterated since it was never previously stated.

Accordingly, Applicants request that in the alternative to a Notice of Allowance, the finality of the previous Office Action should be withdrawn.

CONCLUSION

All pending claims are now allowable and Applicants therefore respectfully request a Notice of Allowance from the Examiner. Should the Examiner have questions, the Applicants' undersigned agent may be reached at the number provided.

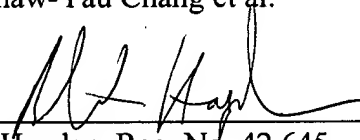
Respectfully submitted,

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Date:

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